<center>**REMARKS/ARGUMENTS**</center>

The rejections presented in the Office Action dated June 27, 2008 (hereinafter Office Action) have been considered. Claims 1-17 and 19-32 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-18 and 32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 and 26 of U.S. Patent No. 6,757,722 to Lönnfors et al. While the Applicants do not reach or necessarily acquiesce with the issue of whether Claims 1-18 and 32 are patentably distinct from U.S. Patent No. 6,757,722, the Applicants submit herewith a terminal disclaimer to obviate any response to the issue on the merits.

The specification has been objected to as failing to provide proper antecedent basis for the claimed subject matter. Particularly, the Examiner objected to the Specification for allegedly not describing a "computer-*readable* medium," although the Examiner notes that the Specification includes references to "computer-*usable* mediums." The Applicants respectfully traverse the objection, as the Specification indeed includes references to computer-readable mediums. For example, on page 5 beginning at line 20, the Specification recites "[i]n accordance with another embodiment of the invention, a computer-implemented method is provided, where a computer-readable medium has stored thereon computer-executable instructions for...." Additionally, on page 6 beginning at line 3, the Specification recites "[i]n accordance with another embodiment of the invention, a computer-implemented method is provided, where a computer-readable medium has stored thereon computer-executable instructions for...." Further still, on page 23 beginning on line 26, the Specification recites:

> In one embodiment, software for carrying out the partial presence notification operations in accordance with the present invention may be stored and distributed on a **CD-ROM 916, diskette 918 or other form of media capable of portably storing information. These storage media may be inserted into, and <u>read by</u>, devices** such as the CD-ROM drive 914, the disk drive 912, etc. (emphasis added)

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These and other references in the Specification support the claimed "computer-readable medium."

However, in order to facilitate prosecution of the application, the Specification has been amended to provide verbatim support in the detailed description section of the application, without the addition of new matter. M.P.E.P. §608.01(l) states that the Applicants may rely not only on the description and drawings as filed for supporting the written description requirement, but also on the original claims if their content justifies it. Thus, the subject matter of original claims forms part of the original description. The "computer-readable medium" of Claims 1-17 has been added by amendment to the Specification at the paragraph starting on page 24, line 15. The amendments correspond directly to the language of independent Claims 1 and 17, and thus no new matter has been added. Withdrawal of the rejection is respectfully solicited in view of the existing support for computer-readable mediums and/or in view of the amendment to the Specification.

Claims 1-18 are rejected based on 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Applicants respectfully traverse the rejection. Claim 18 has been cancelled without prejudice or disclaimer, and thus the rejection to Claim 18 is now moot.

Regarding Claims 1-17, the Examiner argues that these claims are directed to "a computer-readable medium that may be interpreted to read on the applicant's disclosed transmitting medium (page 24, lines 15-28), which is disclosed as being possible data transmissions." The Applicants respectfully disagree. The language in the Applicants' Specification identified by the Examiner distinguishes between mediums in which instructions are stored, and mediums in which instructions are transmitted. For example, page 24, lines 18-21 states: "...a computer program that *exists permanently or temporarily on any computer-usable medium* **or** *in any transmitting medium which transmits such a program*." Further, page 24, lines 22-28 identify representative storage media, and then identify representative transmission media. Independent Claim 1 clearly states "[a] computer-readable medium **having instructions stored thereon**...." Independent Claim 17 clearly states "[a] computer-readable medium **having instructions stored thereon**...." It is respectfully submitted that the language of the claim itself clearly indicates that the instructions are stored on storage media,

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which does not implicate the "air" or other *transmission* media. Nowhere in the Specification does it suggest that the air or other *transmission* media would have "instructions **stored** thereon."

During examination, an Examiner is entitled to give the broadest reasonable interpretation of the claims (M.P.E.P. §2111). This interpretation must, among other things, be reasonable, consistent with the Specification, and recognizable as the meaning to a person of ordinary skill in the art in question at the time of the invention. (*e.g.*, M.P.E.P. §§ 904.01, 2111, 2111.01). As Claims 1-17 expressly indicate that the computer-readable medium has "instructions **stored** thereon," it is respectfully submitted that it is not a reasonable interpretation to suggest that this claim language includes a transmission medium. For at least these reasons, the Applicants respectfully request reconsideration and withdrawal of the rejection to Claims 1-17 under 35 U.S.C. §101.

Claims 1, 2, 4, 10-14, 16 and 18-32 are rejected based on 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,658,095 to Yoakum et al. (hereinafter "*Yoakum*"). The Applicants respectfully traverse the rejection. It is first noted that Claim 18 has been cancelled, and therefore the rejection to Claim 18 is now moot.

Independent Claim 1 is first considered. Among other things, Claim 1 includes creating a presence document including presence information corresponding to the presentity, configuring the presence information as partial presence information comprising less than a total of the presence information available for the presentity, and communicating the presence document having the partial presence information to the requesting terminal. Thus, when communicating the presence document to a requester, not all of the presence information is provided, but rather only a portion of the presence information is provided.

Yoakum is generally directed to a manner of developing presence information based on the status or profile of the user. Depending on the profile or status of the user, the presence information will naturally differ. However, regardless of what input is used to establish the presence information in *Yoakum*, all of the presence information for the current profile is sent to the subscriber. Nothing in *Yoakum* describes, or suggests, that once presence information is established based on a user's status, only a portion of that presence information is actually sent to a subscriber.

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For example, even in the case of *Yoakum*'s different categories, *Yoakum* describes that presence information is created for each presence category to send to the subscribing presence applications (*e.g.,* column 9, lines 28-32). *Yoakum* does not indicate that any lesser portion than all of that created presence information is sent to the subscribing user. In the event of a presence update, nothing in *Yoakum* indicates that anything other than sending an entire new set of presence information. Nowhere does *Yoakum* indicate that only a part of that created presence information would be communicated.

The Examiner specifically identifies column 7, lines 54-65 as teaching the configuration of presence information as partial presence information comprising less than a total of the presence information available for the presentity. The cited portion is reproduced below.

> As noted, the categories may be created for a single subscriber via the user's associated presence application 24 or for a group of subscribers. At this point, the rules management logic 58 and device management logic 60 are configured for a given user.
>
> The rules typically define how to evaluate the state information and deliver the resultant presence information for each presence category. For each presence category, a user may establish rules to control how they should be contacted based on the state of one or more associated devices. For example, the following hierarchy may be implemented for a first presence category....

As the language indicates, the rules are used to evaluate the state information and deliver "resultant presence information" for each presence category. This "resultant" presence information is sent, presumably in its entirety as nothing in *Yoakum* indicates otherwise. The Examiner argues that the rules are applied to the status information to provide only the information which is requested to the subscribers. However, the Examiner is referring to *Yoakum*'s status information that is used to create the resultant presence information, and once the resultant presence information is created, it is presumably always sent in its entirety to a requesting subscriber – or at least there is nothing in *Yoakum* to indicate that only a portion of that presence information is sent to a requesting subscriber.

To anticipate a claim, the reference must teach every element of the claim. See, *e.g.,* *Verdegaal Bros. v. Union Oil Co. of California,* 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.*

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every element of the claimed invention must be literally present, "*arranged or combined in the same way as recited in the claims.*" *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1370, C.A.Fed. (Ariz.), October 20, 2008 (NO. 2007-1565) (emphasis added). It is respectfully submitted that at least the aforementioned claim limitations are not being properly considered, as they are not described in *Yoakum*. Because *Yoakum* fails to teach these limitations as arranged or combined in the same way as recited in Claim 1, legal error has resulted. The Applicant respectfully submits that *Yoakum* does not teach elements of independent Claim 1, and therefore fails to anticipate Claim 1.

For at least these reasons, it is respectfully submitted that *Yoakum* does not teach what is it is purported to teach. It is respectfully submitted that Claim 1 is in condition for allowance over *Yoakum*.

Dependent Claims 2, 4, 10-14 and 16, which are dependent from independent Claim 1, were also rejected under 35 U.S.C. §102(e) as being unpatentable over *Yoakum*. While the Applicants do not acquiesce with the particular rejections to these dependent claims, including any assertions concerning inherency, these rejections are moot in view of the remarks made in connection with independent Claim 1. These dependent claims include all of the limitations of Claim 1 and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 2, 4, 10-14 and 16 are also in condition for allowance.

Independent Claim 19 is next considered. Among other things, Claim 19 includes a watcher application that generates a request(s) for presence information, and receives partial presence information including less than the totality of the presence information available for the presentity(s). The memory updates portions of the presence information identified as partial presence information. Thus, the received presence information is less than the total presence information available, and the "portion" of the presence information that has been identified as "partial presence information" is what is updated at the memory.

As noted above, nothing in *Yoakum* describes, or suggests, that once presence information is established based on a user's status, only a portion of that presence information is actually received by a subscriber's watcher application. Thus, the arguments presented above are equally applicable for this limitation set forth in independent Claim 19.

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There is also nothing in *Yoakum* that would indicate that presence information stored at a UE is updated in a manner that the portions of the presence information "identified by the partial presence information" is updated. *Yoakum* appears to be completely silent on this point. The Examiner cites column 9, lines 4-20 as teaching such a memory that stores the presence information and updates portions of the presence information identified as partial presence information. The Applicants respectfully disagree. The cited portion only indicates that the presence system of *Yoakum* will "provide presence information to the presence application 24 as state information from the devices changes **in a manner warranting a presence update** (step 206)." (emphasis added). Nothing in *Yoakum* indicates that a "presence update" is anything but a standard update where all information is sent. In other words, *Yoakum* merely indicates that the information required updating, but nowhere does it teach, suggest or otherwise contemplate that some **portion** of stored presence information at a watcher application will be updated. Nowhere does *Yoakum* describe updating less than all of the presence information. In order to support an anticipation rejection, *Yoakum* must explicitly teach what is claimed, and *Yoakum* clearly does not teach that some portion of the presence information is updated without requiring all of the presence information to be communicated upon a change of presence information. For at least these reasons, Claim 19 is patentable over *Yoakum*.

Dependent Claims 20-30, which are dependent from independent Claim 19, were also rejected under 35 U.S.C. §102(e) as being unpatentable over *Yoakum*. While the Applicants do not acquiesce with the particular rejections to these dependent claims, including any assertions concerning inherency, these rejections are moot in view of the remarks made in connection with independent Claim 19. These dependent claims include all of the limitations of Claim 19 and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 20-30 are also in condition for allowance.

Independent Claim 31 includes a transceiver limitation that includes receiving partial presence notifications providing partial change information relating to the presence information of the target presentity, and where the processor directs the memory to update the presence information with the partial change information. As indicated above in connection with the

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Applicants remarks to the rejection of independent Claim 19, *Yoakum* does not teach at least the claimed features of providing partial change information relating to the presence information of the target presentity, and updating the presence information with the partial change information. For at least these reasons, *Yoakum* does not anticipate independent Claim 31, and withdrawal of the rejection is respectfully solicited.

Independent Claim 32 includes a processor that is configured to create a presence document including the presence information corresponding to the presentity, where the presence information is configured as *partial presence information corresponding to a subset of a set* of presence information available for the presentity. The data transmission module communicates the *partial* presence information by way of the presence document. As indicated above, *Yoakum* does not teach at least these claimed features. Nothing in *Yoakum* describes, or suggests, that once presence information is established based on a user's status, only a portion of that presence information is actually sent to a subscriber. Even in the case of *Yoakum*'s different categories, *Yoakum* describes that presence information is created for each presence category to send to the subscribing presence applications (*e.g.,* column 9, lines 28-32). *Yoakum* does not indicate that any subset of the presence information is sent to the subscribing user. In the event of a presence update, nothing in *Yoakum* indicates that anything other than sending an entire new set of presence information. For at least these reasons, *Yoakum* does not anticipate Claim 32, and withdrawal of the rejection is respectfully solicited.

Claims 3 and 5 are rejected based on 35 U.S.C. §103(a) as being unpatentable over Yoakum. The Applicants respectfully traverse the rejection. The rejection of Claims 3 and 5 is based on the *Yoakum* reference, in that the Examiner relies on the *Yoakum* reference as teaching all of the limitations of Claims 3 and 5 that stem from independent Claim 1. While the Applicants do not acquiesce with the Examiner's correlation of *Yoakum* and "official notice" as it pertains to the particular language of dependent Claims 3 and 5, *Yoakum* still fails to teach at least the limitations described above in connection with the rejection of Claim 1. As noted above, *Yoakum* fails to teach, or suggest, as least the limitations of independent Claim 1 identified above. Thus, *Yoakum* fails to teach or suggest at least those features in connection with dependent Claims 3 and 5. Accordingly, Claims 3 and 5 are patentable over *Yoakum*, as *Yoakum* fails to teach or suggest all of the limitations of these dependent claims.

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Claims 6-8 and 15 are rejected based on 35 U.S.C. §103(a) as being unpatentable over Yoakum in view of U.S. Publication No. 2002/0129103 by Birkler (hereinafter "*Birkler*"). The Applicants respectfully disagree, and traverse the rejection. The rejection of Claims 6-8 is based on the *Yoakum* reference in that the Examiner relies on *Yoakum* as teaching all of the limitations of Claim 5 (and thus Claim 1). Similarly, the Examiner relies on *Yoakum* as teaching the limitations of Claim 15 that stems from independent Claim 1. The Examiner does not rely on the second cited reference, *Birkler*, as teaching or suggesting limitations of independent Claim 1 or dependent Claim 5, nor does *Birkler* remedy the deficiencies of *Yoakum* in this regard. Therefore, a combination of *Yoakum* and *Birkler* also fails to teach or suggest what is set forth in independent Claim 1 (and consequently dependent Claim 5), and therefore fails to teach or suggest what is set forth in their claims depending therefrom, including Claims 6-8 and 15. The Applicants respectfully submit that dependent Claims 6-8 and 15 are in condition for allowance over the cited combination of references, at least for the reasons set forth above in connection with the remarks and/or amendments to independent Claim 1.

The Applicants note the conditional allowability of Claim 17 over the prior art of record, and thank the Examiner for favorable consideration of this claim. The terminal disclaimer submitted herewith removes the obviousness-type double patenting rejection to Claim 17, and therefore Claim 17 is now in condition for allowance. Claim 17 has not been rewritten in independent form, as the Applicants respectfully submit that it is allowable at least based on the allowability of independent Claim 1.

The Applicants also note the conditional allowability of Claim 9. Claim 9 was objected to as being dependent upon a rejected base claim, but the Examiner noted Claim 9 would be allowable if rewritten in independent form and is also subject to rejections based on double patenting and 35 U.S.C. §101. The Applicants respectfully submit that the remarks provided herein establish the allowability of independent Claim 1, from which Claim 9 is dependent. Further, the terminal disclaimer submitted herewith removes the obviousness-type double patenting rejection to Claim 9. Therefore it is believed that Claim 9 is in condition for allowance.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.019C1) any necessary fees for this filing. If the Examiner would find it helpful, the Examiner is invited to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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